Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN E. SCHOMMER

Appeal No. 1998-2084
Application No. 08/642,962

ON BRIEF

Before STONER, *Chief Administrative Patent Judge*, McCANDLISH, *Senior Administrative Patent Judge* and FRANKFORT, *Administrative Patent Judge.*

FRANKFORT, *Administrative Patent Judge.*

DECISION ON APPEAL

John E. Schommer (appellant) appeals from the final rejection[1] of claims 1-11. The examiner having withdrawn a rejection of claim 11 under 35 U.S.C. § 112, first paragraph in his answer,[2] the sole issue[3] before us is whether claims 1-11 properly stand rejected under 35 U.S.C. § 103 as unpatentable over U.S. Patent No. 4,918,763 to Brotcke.[4] Having carefully considered

[1] Paper No. 6, mailed December 30, 1997.
[2] Paper No. 13, mailed May 12, 1998.
[3] We note that the examiner's refusal to consider the affidavit (attached to Paper No. 7) submitted under 37 CFR § 1.132 relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review the issue raised by the appellant on page 5 of the brief.
[4] Issued April 24, 1990.

the respective positions of the appellant stated in the brief [5] and of the examiner stated in the answer, we find ourselves of the view that the examiner has not made out a case establishing the *prima facie* obviousness of appellant's claimed subject matter. Accordingly, we *reverse.*

Claim 11 is directed to a "method for testing for water leakage from the flush ports of a toilet having a flush surface" whereas claim 1 is for a "method of checking for water leakage in a fixture having a surface that is periodically flushed by a flushing mechanism which introduces water from a source thorough ports above said surface such that water subsequently flows immediately over the surface to a drain, said mechanism being designed to then terminate the flow until the next periodic flush." Claim 11, the more succinct of these two claims, requires the method steps of:

- squirting a swath of dye onto the [flush] surface just below the flush ports;
- before flushing the toilet, observing the swath of dye to render an observation; and
- correlating the streaks observed in the swath of dye during the observation to water leakage.

Claim 1, on the other hand, requires the steps of:

- applying a swath of dye having a color visually distinct from the color of said surface to said surface below said ports in places at which it is desired to check for trickle leaks from said source;
- after applying the dye to the surface and before flushing the fixture, observing said swath of dye; and,

[5]Paper No. 12, filed March 30, 1998.

- noting any streaks down through said swath of dye which reveal the surface through said dye before flushing the fixture and after applying the dye to determine whether water from the source is leaking through one or more of the ports when the fixture is not being flushed.

As an initial matter, it is necessary for us to construe the meaning of the term "swath" as used in claims 1 and 11. The specification does not expressly define the term "swath". However, in discussing the formation of the "swath" appellant states, "A quick squirt [of dye] around the entire perimeter of the bowl will create a bead of the dye liquid which would immediately sag to create a swath as shown in Figure 2." (specification, p. 7, lines 2-4). Inspection of Fig. 2 reveals that the dye is shown as covering approximately half of the surface on the side of the toilet bowl. Knowing that toilet bowls are generally about 7 to 7 ½ inches deep (*see* ANSI A112.19.2m-1982, attached, Figs. 3-13), we find that the width of the swath as shown in Fig. 2 would be on the order of several inches (e.g., 2-4 inches).

Now directing attention to column 1, lines 16 through 47 of Brotcke (which contains a description of a prior art standard or procedure for evaluating "rim wash" in a toilet classified as "water-saving" under U.S. standards), the examiner states: "With the disclosure alone of ANSI where a contrasting color line is applied around the toilet bowl and subsequent observation of the line is made for passage of water therethrough, it would have been obvious to the ordinary artisan, to employ this methodology for observation of passing water at any point in time" (answer, p. 3). The examiner further observes that, "[W]ith the knowledge of applying drops of [dye] in a water tank and observing for colored water to pass in a static state of a tank and bowl

it would have been obvious to the ordinary artisan to conduct this observation test with the ANSI applicator in lieu of the drops of [dye] as they would offer obvious alternatives to the ordinary artisan" (answer, pp. 3-4).

Our review of Brotcke reveals that the examiner is relying upon a "rim wash" procedure set forth in ANSI standard A112.19.2M – 1982 for vitreous china plumbing fixtures. Because it does not appear that the examiner reviewed the contents of the ANSI standard referenced, we have done so and find that the standard, as it relates to "rim wash," (including footnote 2) reads as follows (pp. 10-11):

> **7.4.4 Washing of Flushing Surface (Rim Wash)**
> **7.4.4.1 Ink Test**
> **7.4.4.1.1 Test Method**
> *(a) Test Media*. The test media shall be applied by an artist's fine-point felt-tipped pen[2] containing a dark-colored, water-soluble ink.
> *(b) Procedure*. Scrub the flushing surface clean with commercial scouring powder to remove any buildup or deposits on the walls. Rinse the surface and dry with oil-free air.
> Ink a line around the circumference of the flushing surface at a level 1 in. (25mm) below the rim jets of the bowl.
> Trip the flush release device and observe the line during and after the flush. When the flushing cycle is completed (tank completely refilled or flushometer cycle complete and trap refill water delivery completed), measure the lengths of the unwashed line segments where the ink may have remained on the flushing surface, and their approximate positions in the bowl. This completes one test run.
> Repeat the procedure until three sets of data are obtained. If any portion of the ink line is removed by splashing water, disregard the test run and retest.
> *(c) Report*. Report the number and lengths of ink line segments remaining and their positions in the bowl.

[2] Information concerning apparatus and test media specifications, sources of supply, and availability of test kits is obtainable from Building Technology Research Division, Davidson Laboratory, Stevens Institute of Technology, Castle Point Station, Hoboken, NJ 07030. See Appendix for description of test media.

> **7.4.4.1.2 Performance Requirement.** The total length of ink line segments remaining on the flushing surface after each initial flush shall not exceed 2 in. (50 mm) and no individual segment shall be longer than ½ in. (13 mm) based on the average of the three test runs.
> The relevant portion of the appendix (p. 36) includes this entry:
>
> A.3.4 Ink Test (7.4.4.1)
>
> Marking Pen – Felt-Tipped
> Water Soluble Ink
> Pentel Model PM2 or equal

Following this trail to its conclusion, we have obtained a copy of a document entitled "PENTEL SPECIFICATION PM2" which indicates that this pen includes a tip of "bonded acrylic fibers," uses ink of a "water base" type, and will create a line width of "1 mm – 1.2 mm depending on writing pressure & desired use." Copies of pages 1, 11, 17-22, and 36 of the ANSI standard and of the Pentel Specification are supplied with this decision and the documents are listed on the attached form PTO-892.

Appellant's method claims require the application (claim 1) or squirting (claim 11) of a swath of dye onto the flush surface of the toilet, whereas ANSI calls for an ink line to be applied by a fine-point felt-tipped pen. It is the examiner's contention that "[i]t is deemed within the skill of the ordinary artisan that a general 'squirting' application of dye [i.e., application of a swath of dye] is equivalent to a physical applicator [i.e., application of an ink line]." (answer, p. 5). The examiner's contention is not well taken. The examiner has pointed to no evidence of the equivalence of the ink line disclosed by ANSI and the swath of dye required by appellant's claims 1 and 11. Moreover, there are at least two important distinctions between the ink line and the swath. First is a difference of magnitude. The ink line disclosed by ANSI is 1 to 1.2 mm

wide, whereas the swath disclosed by appellant is on the order of several inches wide. Second, the swath is created by sagging of a bead of dye (specification, p. 7, lines 2-4), whereas there is no indication that the ink line of ANSI applied by a fine point, felt-tipped pen sags after application thereof to the toilet bowl. In view of these distinctions and in the absence of evidence to the contrary, we find that the dye swath claimed by appellant is not the equivalent of the ink line disclosed in Brotcke and by ANSI.[6]

The examiner has further relied upon appellant's own disclosure to show equivalence stating at page 5 of the answer that "[T]his is evidenced by the instant disclosure at page 3, line 13 which refers to 'squirts or otherwise applies';, [sic] page 5, line 6 refers to 'four possible applicator styles'; and the description of Figure 8 on page 8, equates known applicators shown in Figure 8 of the instant disclosure." We think the examiner's reasoning is flawed. By relying on appellant's own specification to show equivalence, the examiner is engaging in impermissible hindsight. Moreover, appellant's own disclosure does not support a showing of equivalence. Nowhere in appellant's specification is an ink pen used to apply dye. Nor has appellant made any admissions in the specification or throughout the prosecution history of the present application that an ink pen is the equivalent of any of the dye applicators shown in Figs. 2, 3 or 8.

[6] Per MPEP § 2144.03, appellant has repeatedly (Paper No. 4, p.5; Paper No. 7. p.2, brief, pp. 9-11) requested a showing of the equivalence of squirting dye into a toilet bowl and inking a line in a toilet bowl. The examiner has failed to comply with the provisions of MPEP § 2144.03; however, in view of our finding that the dye swath disclosed by the appellant is not the equivalent of the ink line disclosed by ANSI and Brotcke, the examiner's failure to make the required showing is moot.

In view of the deficiencies discussed above, we conclude that the examiner has not met his burden of setting forth a *prima facie* case of obviousness. Accordingly, the decision of the examiner rejecting claims 1 through 11 under 35 U.S.C. § 103 based on Brotcke is *reversed.*

NEW GROUND OF REJECTION

Under the provisions of 37 C.F.R. § 1.196(b) we reject claims 1-11 under 35 U.S.C. § 103 as being unpatentable over LYSOL Disinfectant Fresh Scent Cling, Thick Liquid Toilet Bowl Cleaner, 1995 [LYSOL].[7] Concerning this rejection, we make the following findings:

1. We take official notice that ordinary toilets, such as the one shown in the illustration on the LYSOL front label, are fixtures having a surface that is periodically flushed by a flushing mechanism which introduces water from a source through ports above the surface such that water subsequently flow immediately over the surface to a drain and that the flushing mechanism is designed to terminate the flow of water until the next periodic flush.

2. We take official notice that ordinary toilet bowls have ports that communicate with an annular water reservoir at the top of the bowl, and that said annular reservoir includes an annular arrangement of said ports and that such conventional toilet bowls have a waterline and an exposed surface above the waterline.

[7] A bottle of LYSOL Disinfectant Fresh Scent Cling, Thick Liquid Toilet Bowl Cleaner was retrieved from the linen closet of one of the members of this panel. Copies of the bottle's labels are supplied with this decision and listed on the attached form PTO-892. Consultation with the manufacturer indicates that the product label has been in the form shown since at least 1995.

3. LYSOL discloses a method for cleaning toilet bowls.

4. LYSOL gives the following cleaning instructions:

Raise the toilet seat. Flush bowl and remove heavy soil by scrubbing with a stiff brush prior to using product. Point top of the bottle down into the bowl. Squeeze gently, directing at least 4 oz. (squeeze bottle approximately 15 seconds) of the liquid under the rim and on the sides of the bowl, letting it run down into the water. Let stand for at least 10 minutes, then brush the entire bowl and flush. Rinse brush in fresh bowl water after each use.

5. As shown in the illustration on the front label and as confirmed by inspection of the contents of the bottle, LYSOL's toilet bowl cleaner is blue in color, a color which is visually distinct from the color (white) of the toilet bowl.

6. Webster's Ninth New Collegiate Dictionary, 1985, defines "dye" as:

1: color from dyeing 2: a soluble or insoluble coloring matter.

7. LYSOL's toilet bowl cleaner includes soluble coloring matter and thus is broadly a "dye."

8. As shown in the illustration on the front label, in the method disclosed by LYSOL the toilet bowl cleaner (dye) is squeezed onto the surface of the toilet under the rim and on the sides of the bowl (finding 4) which includes the area just below the flush ports.

9. In the method disclosed by LYSOL the toilet bowl cleaner (dye) runs down into the water (finding 4) thus forming a swath within the meaning of appellant's claims 1 and 11.

10. In the method disclosed by LYSOL the user is directed to brush the sides of the bowl after letting the dye swath stand for 10 minutes and prior to flushing (finding 4). Such action by the user would necessarily require the user to "observe" the toilet bowl and the cleaner (swath of dye) therein "to render an observation" within the meaning of appellant's claims 1 and 11.

11. Webster's Ninth New Collegiate Dictionary, 1985, defines "notes" as:

1 a: to notice or observe with care b: to record or preserve in writing

12. The instant specification makes no mention of a requirement for writing for the step of "noting" to be accomplished. Thus, "noting" as used in claim 1, is no more than the mental act of noticing or observing.

13. As discussed above in finding 10, the method disclosed by LYSOL necessitates observation and, thus, also encompasses "noting" of the condition of the dye swath.

14. Webster's Ninth New Collegiate Dictionary, 1985, defines "correlate" as:

1. a: to establish a mutual or reciprocal relation between <~ activities in the lab and the field> b: to show correlation or causal relationship between 2: to present or set forth so as to show relationship.

15. The LYSOL method directs the user to apply the toilet bowl cleaner under the rim and on the sides of the bowl (finding 4). Such application would necessarily

result in application of the cleaner substantially continuously around the upper portion of substantially the entire bowl beneath the array of ports.

16. As shown in the illustration on the front label, in the LYSOL method the toilet bowl cleaner is contained in a squirt bottle having a directional squirting tip and a swath of cleaner is squirted around an upper portion of the bowl (findings 4 and 9).

17. In LYSOL's method the user is directed to squeeze cleaner under the rim and on the side of the bowl, "letting it run down into the water" (finding 4). Such a procedure would necessarily result in coating the exposed surface of the bowl substantially continuously around the upper portion of the entire bowl beneath the array of water ports.

18. We note that waiting 10 minutes encompasses waiting a number of seconds.

19. Appellant expresses the equivalence of squirt bottles and spray bottles for the application of a swath of dye (specification, page 3, lines 13-15; page 8, lines 7-9).

20. We take official notice that there are many equivalent squirt and spray dispensers for household cleaning products on the market, well known to users of such products.

21. We take official notice that well known conventional urinals have a back splash and utilize a SLOAN valve.

22. We take official notice that ordinary bidets have a substantially continuous annular flushable surface and a water source comprising a substantially continuous flushing water reservoir disposed above the flushing surface.

23. We take official notice that urinals and bidets are cleaned using the same products and methods as toilet bowls.

24. We take official notice that a common way of marking time is by counting.

DISCUSSION

LYSOL's method practiced on an ordinary toilet bowl meets all the limitations of appellant's claim 1 (findings 1-13) except for noting any streaks down through the swath of dye before flushing the fixture and after applying the dye "to determine whether water from the source is leaking through one or more of the ports when the fixture is not being flushed"; however, a user following the LYSOL method would necessarily note any such streak through the swath of dye and mentally make this determination. The LYSOL method directs the practitioner to wait at least 10 minutes before brushing the bowl. If water were leaking in the bowl, the 10 minute waiting period would provide sufficient time for streaks to be formed in the swath of toilet bowl cleaner. A practitioner observing the swath of cleaner prior to brushing would necessarily notice these streaks and upon casual contemplation of how they were formed conclude that they were formed by water flowing through the swath of cleaner. As the only source for the water entering the bowl at this time is a leak between the toilet tank and bowl, the practitioner would logically understand (determine) that water is leaking from the water source.

To assume otherwise is to assume that the practitioner has no skill in understanding the operation of an ordinary toilet. See, *In re Sovish,* 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

Similarly, LYSOL's method practiced on an ordinary toilet bowl meets all the limitations of appellant's claim 11 (findings 1-13) except for the step of "correlating streaks observed in the dye during the observation to water leakage." In our view, a user following the LYSOL method would inevitably make this correlation. Correlating means recognizing a mutual or reciprocal relationship (finding 14). As streaks in the dye on the flush surface of a toilet before flushing and after applying the cleaner (dye) thereto could only be formed by water leakage, the relationship would be self evident and thus obvious to one of ordinary skill in the art.

The additional limitations set forth in claims 2-4 and 8 are met by LYSOL (findings 15-18, respectively.

As for claim 5, appellant has expressed the equivalence of squirt bottles and spray bottles for applying a swath of dye (finding 19). Moreover, we have taken official notice (finding 20) of the equivalence of such bottles for dispensing household cleaning products. Accordingly, it would have been obvious to one of ordinary skill in the art to substitute a spray bottle for the squirt bottle disclosed by LYSOL. See, *In re Fout*, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA, 1982), wherein the court indicated that an express suggestion is not required to substitute one equivalent for another.

As to claims 6, 7 and 10, LYSOL discloses a method for cleaning toilet bowls. Claim 6 is directed to an ordinary conventional urinal (finding 21), claim 7 is directed to an ordinary

conventional bidet (finding 22), and claim 10 is directed to a fixture with a SLOAN valve which encompasses ordinary conventional urinals (findings 21). It is common for practitioners to clean urinals and bidets with the same products and using the same methods as they clean toilet bowls (findings 23). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to use the LYSOL product and method on ordinary conventional urinals and bidets within the meaning of appellant's claims 6, 7 and 10.

As to claim 9, LYSOL discloses a method including waiting a period of ten minutes (finding 4). It is well known to mark time by counting (finding 24). Furthermore, counting to 600 seconds (to mark off approximately 10 minutes required in LYSOL's method) encompasses counting to five.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review." 37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

BRUCE H. STONER, JR., Chief Administrative Patent Judge	)	
HARRISON E. McCANDLISH Senior Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
CHARLES E. FRANKFORT Administrative Patent Judge	)	

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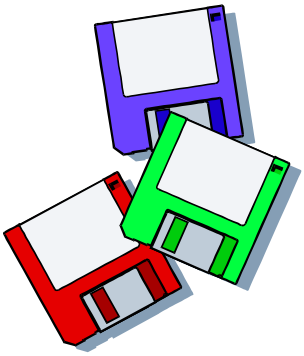

Appeal No. 1998-2084
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DECISION: REVERSED; 1.196(b)

Prepared: May 12, 2004

Draft Final

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PALM / ACTS 2 / BOOK

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